

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of the claims**

Claims 1-4 and 6-20 were pending and under active consideration in the subject application. With this submission, claims 3, 7, 8, 10, 15, 16 and 19 have been amended, but no claims have been canceled nor newly added. Hence, upon entry of this Response, claims 1-4 and 6-20 will remain pending and under active consideration.

**Allowable subject matter**

Claims 8-15 stand objected to for being dependent upon a rejected base claim. Applicant thanks the Examiner for his indication that same claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has redrafted claims 8 and 10 in independent form in keeping with the Examiner's suggestion.

**Claim rejections under 35 U.S.C. § 112, second paragraph**

Claims 3, 16 and 18 stand rejected under the second paragraph of 35 U.S.C. § 112 as being allegedly indefinite for the misspelling of "phosphites" as "fosfites."<sup>1</sup> Applicant thanks the Examiner for his careful reading of the claims and has revised the claims (and specification) accordingly.

**Claim objections under 35 U.S.C. § 103**

Claims 1-4, 6, 7 and 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over USP No. 6,569,927 to Michael Gelbin ("Gelbin") in view of USP No. 5,362,572 to Hamada

*et al.* (“Hamada”). Though the Examiner appears to acknowledge that the cited art does not teach the selection of “a polyisobutene having a glass transition temperature of less than -20°C and surface tension of less than 40 mN/m at a temperature above the glass transition temperature of said polyisobutene,” the Examiner contends that these limitations are obvious “[s]ince the criticality of the claimed [glass transition temperature]  $T_g$  and surface tension is not elucidated in the specification.” Applicant respectfully traverses the rejection.

The claimed invention is directed to compositions comprising a specific class of polyisobutenes—those having the recited  $T_g$  and surface tension—from a universe of potential polyisobutenes. Applicant respectfully notes that the specification does, in fact, discuss the importance of these parameters. At page 6, paragraph 5 of the application, for example, the significance of the  $T_g$  is described in detail. *To wit*, the upper limit of the  $T_g$  defines a maximum molecular weight (“MW”) for the polyisobutenes in that the  $T_g$  is directly correlated to a polymer’s MW—*i.e.*, the higher the MW, the higher the  $T_g$ . Similarly, as explained in detail in the first paragraph of page 7, the surface tension is used to distinguish very low MW polyisobutenes from the polyisobutenes according to the invention and therefore defines a minimum for the MW. In short, the  $T_g$  and surface tension define a specific range of MWs for the claimed polyisobutene.

Hence, the mere disclosure of polyisobutene among a “laundry list” of conceivably thousands of polyolefins is insufficient to have led one of ordinary skill in the art to specifically select polyisobutene, let alone a polyisobutene having the specific  $T_g$  and specific surface tension as recited in the claims. In fact, all of the examples of Gelbin are directed to compositions comprising polypropylene. Hamada does not cure this deficiency of Gelbin. Thus, insofar as the ordinary artisan would not have found a reason to select the claimed polyisobutene from cited references, a *prima facie* case of obviousness cannot be sustained on the cited references. Applicant accordingly solicits respectfully the withdrawal of the rejections for obviousness.

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<sup>1</sup> Applicant assumes that the Examiner inadvertently rejected claim 18, which does not recite “fosfites,” for claim 19, which does.

## Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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